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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,887	08/04/2003	Michael Francis X. Gigliotti JR.	132497	6533

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GENERAL ELECTRIC COMPANY
GLOBAL RESEARCH
PATENT DOCKET RM. BLDG. K1-4A59
NISKAYUNA, NY 12309

EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/633,887

Applicant(s)

GIGLIOTTI ET AL.

Examiner

Marc S. Zimmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/24/05 and the interview of 04/19/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 and 22-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 13, 15-21, 37 and 38 is/are rejected.
- 7) ☒ Claim(s) 14 and 39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/15/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

Applicant is reminded of the telephone interview of April 19 where the Examiner requested that Applicant make a species election from the list of polymer resins outlined in claims 2 and 20. Applicant elected the epoxy resin.

Applicant had already elected claims 1-21 for examination in response to an earlier restriction requirement. (The Examiner had stipulated that both a group and species be elected for prosecution but Applicant had apparently not observed that a species election requirement had also been outlined in the Office action dated February 10, 2005). Of claims 1-21 and 37-39, an epoxy resin is embraced in claims 1-8,13-21, and 37-39. Claims 9-12 are directed to a non-elected species and, hence, are withdrawn from consideration as are claims 22-36.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no antecedent basis in claim 1 for a substrate as is recited in claim 13.

Concerning claim 21, it is appreciated that the preamble of claim 20 does, in fact, mention a surface region of a turbine component. However, the claim as a whole is directed to a **composition** wherein the phrase "for providing aluminum to the surface region of a turbine component" is merely a recitation of intended use. Section 2112.02

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of the MPEP provides direction as to how phrases such as this are to be treated: "If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation"); *Kropa v. Robie*, 187 F.2d at 152, 88 USPQ2d at 480-81 (preamble is not a limitation where claim is directed to a product and the preamble merely recites a property inherent in an old product defined by the remainder of the claim).

Insofar as the aforementioned phrase fails to meet the criteria set forth above, it is assessed little or no patentable weight and, therefore, fails to effectively provide antecedent basis for the mention of this same aspect in claim 21 which, incidentally, is also a **composition** claim. Insofar as the turbine component is not actually a material component of the invention of claim 21, it is not proper to relate the amount of aluminum in terms of the amount in said surface region of the turbine because the turbine is not actually there. It would be more appropriate to add this limitation to claim 37.

For the purpose of evaluating claim 21 against the prior art, the last three lines will be treated as a continuation of the statement of intended use in claim 20.

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Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 6-8, 13-19, 31, and 37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 9, 14-17, 19-21, 32-35, and 40 of copending Application No. 10/836,001.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims fully encompass the inventions claimed by the co-pending reference in view of Applicant's utilization of the transitional phrase "comprising" in claim 1. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261,

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229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts").

The subject matter of claim 39 overlaps with that of claim 40 of the copending reference. The following table outlines other claims having similar subject matter between them:

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2	34
6,7	14,32,33
8	35
13	19
14	9
15	20
16,17	16,17
18	21
19	15

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Analysis

Applicants are advised that the term "aluminizing" is, likewise, directed to intended use as in "a composition for aluminizing". The reference need not disclose this application for a similar composition to be regarded as anticipatory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 15-17, and 19-21 rejected under 35 U.S.C. 102(b) as being anticipated by Sugimoto et al., U.S. patent # 5,322,864. Sugimoto discloses an epoxy resin composition comprising a low viscosity epoxy resin, a liquid curing agent, metal powder of average particle size not exceeding 125 microns, and optionally an inorganic filler other than a metal powder. Of the powders mentioned by the reference, aluminum powder is preferred. Alloys of aluminum and iron or chromium are also mentioned. Additives including thixotropic agents, curing accelerators, dispersing agents, etc. are mentioned in column 5, lines 36-42.

As for claims 16 and 17, there is no indication that either of these materials are present in even adventitious quantities.

Claims 1-7, 16-17, 19-21, and 37-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Geeck, U.S. patent # 4,748,194. Geeck teaches a corrosion resistant coating composition to be applied to gas tank containers comprising a

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powdered metal selected from those identified in column 2, lines 29-33 having an average particle size of less than 40 microns, a linear "epoxy of phenoxy" resin (ostensibly an epoxy group modified phenolic resin), and a crosslinking urethane resin. Organic solvents such as acetone MEK, DMF, aromatic hydrocarbons, and alcohols are suggested in column 3, lines 18-24. Suspending agents (another name for anti settling agents) and hygroscopic agents (another name for driers) are other desirable components disclosed in column 3.

As for claims 16 and 17, there is no indication that either of these materials are present in even adventitious quantities.

Claims 1-2, 4-8, and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Lutz et al., U.S. patent # 5,011,627. Lutz discloses an electrically-conductive paste comprising a blend of the materials outlined in the abstract. Epoxy resins derived from bisphenol A are especially preferred according to column 2, lines 39-43. Silver powder having a flake geometry is recommended in column 2, lines 65-67. The filled epoxy may be diluted with an ethereal- or aromatic/aliphatic hydrocarbon solvent (column 3, lines 22-25). Other acceptable additives include stabilizers and foam inhibitors (column 3, lines 28-29).

Allowable Subject Matter

Claims 14 and 39 are objected to as being dependent upon a rejected base claim, but would be allowable if the obviousness-type double patenting rejection were overcome and they were rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 28, 2005

Marc Zimmer
Marc Zimmer
TC 1700